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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/825,299

04/16/2004

Joseph H. Matthews III

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SUITE 1200

WASHINGTON, DC 20005-4051

EXAMINER

HUYNH, BA

ART UNIT

PAPER NUMBER

2179

MAIL DATE

DELIVERY MODE

08/15/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/825,299	MATTHEWS ET AL.	
	Examiner	Art Unit	
	Ba Huynh	2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 58-82 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 58-82 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 58-82 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-33 of U.S. Patent No. 6,724,405, claims 1-18 of US patent 6,313,851, and claims 1-13 of US patent 6,266,059. Although the conflicting claims are not identical, they are not patentably distinct from each other because the broaden scope of pending claims 58-82 are read on by the patented claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

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pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 69-82 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification fails to provide a detail description for the claimed limitation “executing said application program in response to said second signal” and “displaying a menu responsive to said first signal, wherein said menu is displayed only after said application is executed”, i.e., how the second input signal being executed prior the first input signal. Instead, the spec clearly discloses a first signal for displaying of the menu responsive to the first signal, a second signal for executing an application selected from the displayed menu (see parent application 09/954,167, now US patent 6,724,405, claim 11 in specific)

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 58-82 are rejected under 35 U.S.C. 102(e) as being anticipated by US patent 5,990,890 (Etheredge).

- As for claim 58: Etheredge teaches a system for controlling computer functions, the system capable of operating in a plurality of modes including, mouse input, keyboard input, and remote control input modes (13:34-38). The system comprises a first means for generating a first signal indicating that a menu should be displayed (13:40-49), for generating a second signal for generating a numeric selection (14:11-15:28), for generating a third signal indicating that an application specific function should be performed if the application is operating in the first mode (14:11-15:28), means for displaying data (fig. 14), a third means for receiving the first, second and third signals generated by the first means, and in response to receiving the first signal to display a menu comprising choice of at least one application together with numeric accelerator (14:11-15:28), in response to receiving the second signal launching a selected application, and in response to receiving the third signal causing the launched application to perform a function pertinent to that application if the system is operated in the first mode (14:11-15:28).
- As for claim 60: It would have been readily clear to one of skill in the art that after the system is turn on and before the first input signal is received the display screen should remain clean.
- As for claim 61: Alphanumeric accelerators are overlays in multi-level menu hierarchy (Etheredge's 15:4-9).
- As for claims 62, 63: The user may switch from from keyboard mode to remote control input mode (Etheredge's 13:34-38).

- As for claim 64: The function pertinent to the launched application program is different (in appearance, with or without the accelerator) based on the mode of the system.
- As for claim 65: Different functions of the launched application can be activated (Etheredge's 15:4-9).
- As for claim 66: While operating in remote control mode, the third means receives signals from the remote control only ((Etheredge's 13:34-14:46).
- As for claim 67: The first mode can be a remote control mode ("theater mode", Etheredge's fig. 14)
- As for claims 69, 76: Etheredge teaches a method and corresponding system for controlling computer functions comprising the steps/means for receiving a signal for displaying a menu and a signal for executing an application, the menu is displayed after the application is executed (First embodiment: from the menu bar of figure 14 select an application to execute. A menu is displayed in the menu bar of the executed application. A pull down menu can also be displayed from the menu bar. Since the claims do not clearly recite the temporal order of the first and second signals, the claimed "second signal" is being interpreted as the signal for executing the application, which actually a first input signal).
- As for claims 59, 68: The menu will be displayed in different manner if the first signal had not been received from the first means (i.e., without the accelerator if the remote control is not used).

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- As for claims 70, 77: Etheredge teaches associating an alphanumeric label to an application and launching the application by activating the alphanumeric label (Etheredge's 13:34-14:46, fig. 14).
- As for claims 71, 75, 78, 82: It is inherently included in Etheredge that the executed application can perform a function responsive to a third signal (e.g., by activating a function from the application's menus or icons. Figure 14).
- As for claims 72, 79: The menu comprises at least one application (fig. 14).
- As for claims 73, 80: Figure 14 includes at least one accelerator associated with an application program (Etheredge's 13:34-14:46, fig. 14).
- As for claims 74, 81: The application is launched by activating the corresponding accelerator (Etheredge's 13:34-14:46, fig. 14).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ba Huynh whose telephone number is (571) 272-4138. The examiner can normally be reached on Mon - Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on 571-272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ba Huynh
Primary Examiner
AU 2179
8/9/07


BA HUYNH
PRIMARY EXAMINER